UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,249	05/19/2000	Connie D. Myers	M-8322 US	9379

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EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.		**Applicant(s)**	
Office Action Summary	09/575,249		MYERS, CONNIE D.	
	Examiner		**Art Unit**	
	Jean D Janvier		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2002* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-76* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)		4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .	
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) ☐ Notice of Informal Patent Application (PTO-152)	
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2,3,4,8* .		6) ☐ Other: .	

DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should not exceed 500 characters and should be brief and technically accurate. The title of the invention should be placed at the top of the first page of the specification.

Status of the claims

Claims 1-44 were originally presented and claims 45-76 were added by a preliminary amendment. Claims 1-76 are now pending in the Instant Application.

Claim Objections

Claims 1-76 are objected to because of the following informalities:

Throughout prosecution of the claims on the merits, the Examiner considers a **vendor to be a coupon issuer 14 or distributor 16 and a retailer to be the owner of a retail store where coupons can be redeemed.** However, it appears that the Applicant in many instances, within the claimed invention, uses the terms **vendor and retailer** interchangeably. It is important that the definition of terms remain consistent in the Application in order to avoid any confusion.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 and 45-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. In fact, the process or steps disclosed, for example, in independent claim1 can not yield to a concrete, useful and tangible result since the steps as recited in the claim pertain to a manual process and therefore, the claims (1-22) do not fall within the technological art. In other words, the steps or process of **dispensing information ...**, as recited in claim 1, need to be automated or a computer implementation of the steps or process is necessary. The same remarks are true for claims 45-60.

Claim Rejections - 35 USC § 112

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

As per claim 46, "...**the vendor-identifier list...**" lacks proper antecedent basis in the claim. The Examiner assumes that the Applicant meant to refer to -- ... **a vendor-identifier list** ...--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the
United States before the invention by the applicant for patent, except that an international
application filed under the treaty defined in section 351(a) shall have the effect under this
subsection of a national application published under section 122(b) only if the
international application designating the United States was published under Article
21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States
before the invention by the applicant for patent, except that a patent shall not be deemed
filed in the United States for the purposes of this subsection based on the filing of an
international application filed under the treaty defined in section 351(a).

Claims 1-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al.

(hereinafter Barnett), US Patent 6, 321, 208 B1.

As per claim 1, Barnett discloses a system (advertising medium) for distributing over the

Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific user

using a personal computer 6 of fig. 1 linked to a server or a web server or online service provider

2 having a database 40 (multi-vendor-rebate-list) containing product coupons and information on

products and services (promotional items or advertisements) available for sales at participating

retail stores or online shopping malls and wherein upon connecting to said system or online

service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can download

coupon data directly to his personal computer memory or Hard disk drive where they can be

printed in the form of paper coupons 18 (hard copies-fig. 5). Subsequently, the user takes the

printed coupons to a participating retail store and wherein upon detecting the presence of a UPC

code related to a promotional item associated with a printed coupon in the customer's order, the

coupon is redeemed accordingly, subsequent to verifying the identity of the user or the bearer of

the coupon, and a price reduction is applied to the customer's order and the user's or customer's

transaction data including the coupon redemption information are forwarded to the coupon

distributor 16 and coupon issuer 14 where they can be used to further prepare targeted coupon

packages for the user or customer. In a further embodiment, the user is conducting a business

transaction with an online shopping mall (having a server or e-tail server), which is connected

over the Internet to the online service provider 2 so as to detect (search) in the customer's order

any matching UPC code associated with a discount coupon, stored in database 40 of online

service provider 2, and if a matching UPC code is found, the value of the coupon is determined

or generated in real-time (generating a coupon) and a price reduction is automatically applied to

the customer's order.

It is further to be understood that advertisers or vendors or manufacturers or coupon

issuer 14 and distributor 16 should be able to receive, from the system or advertising medium,

information related, for example, to the number of downloaded coupons, demographic profile of

users downloading specific coupons, number of times a particular coupon was viewed by users,

billing statement concerning the amount of money owed by a vendor, etc., subsequent to

transmitting, by a valid or identified vendor or coupon issuer 14 or distributor 16, a request

(inquiry) requesting such information from the advertising medium or provider 2, wherein part of

this information is used to further prepare customized packages (coupons) in order to target

specific users or customers.

(See abstract; figs. 1, 5; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claims 2-4, 8, 10-22, 47, 51 and 56-60, Barnett discloses a system (advertising

medium) for distributing over the Internet electronic coupons from distributor 16 and coupon

issuer 14 (vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a

web server or online service provider 2 having a database 40 (multi-vendor-rebate-list)

containing product coupons and information on products and services (promotional items or

advertisements) available for sales at participating retail stores or online shopping malls and

wherein upon connecting to said system or online service provider 2 of fig. 1 over the Internet,

the user using personal computer 6 can download coupon data directly to his personal computer

memory or Hard disk drive where they can be printed in the form of paper coupons 18 (hard

copies-fig. 5). Subsequently, the user takes the printed coupons to a participating retail store and

wherein upon detecting the presence of a UPC code related to a promotional item associated with

a printed coupon in the customer's order, the coupon is redeemed accordingly, subsequent to

verifying the identity of the user or the bearer of the coupon, and a price reduction is applied to

the customer's order and the user's or customer's transaction data, including coupon value,

expiration date, product associated with the coupon, the customer's identification, the retail store

where the coupon was redeemed or the coupon redemption information, etc., are forwarded or

transmitted to the coupon distributor 16 and coupon issuer 14 where they can be used to further

prepare targeted coupon packages for the user or customer and pay or compensate the retailer by

crediting the retailer's account or electronically transfer funds to the retailer's bank account

using conventional means for accepting or redeeming the said coupon. In a further embodiment,

the user is conducting a business transaction with an online shopping mall (having a server or e-

tail server), which is connected over the Internet to the online service provider 2 so as to detect

(search) in the customer's order any matching UPC code associated with a discount coupon,

stored in database 40 of online service provider 2, and if a matching UPC code is found, the

value of the coupon is determined or generated in real-time (generating a coupon) and a price

reduction is automatically applied to the customer's order.

It is further to be understood that advertisers or vendors or manufacturers or coupon

issuer 14 and distributor 16 should be able to receive, from the system or advertising medium,

information related, for example, to the number of downloaded coupons, demographic profile of

users downloading specific coupons, number of times a particular coupon was viewed by users,

billing statement concerning the amount of money owed by a vendor or distributor 16 or coupon

issuer 14 to the advertising medium or provider 2 for distributing the coupon issuer 14 or

distributor 16 coupons (advertisements) over the Internet, etc., subsequent to transmitting, by a

valid or identified vendor or coupon issuer 14 or distributor 16, a request (inquiry) requesting

such information from the advertising medium or provider 2, wherein part of this information is

used to further prepare customized packages (coupons) in order to target specific users or

customers.

(See abstract; figs. 1, 5; col. 7: 36-55; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claims 5, 6-7, 48-50 and 52-55, Barnett discloses a system (advertising medium)

for distributing over the Internet electronic coupons from distributor 16 and coupon issuer 14

(vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a web server

or online service provider 2 having a database 40 (multi-vendor-rebate-list) containing product

coupons and information on products and services (promotional items or advertisements)

available for sales at participating retail stores or online shopping malls and wherein upon

connecting to said system or online service provider 2 of fig. 1 over the Internet, the user using

personal computer 6 can download coupon data directly to his personal computer memory or

Hard disk drive where they can be printed in the form of paper coupons 18 (hard copies-fig. 5).

Subsequently, the user takes the printed coupons to a participating retail store and wherein upon

detecting the presence of a UPC code related to a promotional item associated with a printed

coupon in the customer's order, the coupon is redeemed accordingly, subsequent to verifying the

identity of the user or the bearer of the coupon, and a price reduction is applied to the customer's

order and the user's or customer's transaction data, including coupon value, expiration date,

product associated with the coupon, the customer's identification, the retail store where the

coupon was redeemed or the coupon redemption information, etc., are forwarded or transmitted

to the coupon distributor 16 and coupon issuer 14 where they can be used to further prepare

targeted coupon packages for the user or customer and/or pay or compensate the retailer by

crediting the retailer's account or electronically transfer funds to the retailer's bank account

using conventional means for accepting or redeeming the said coupon. In a further embodiment,

the user is conducting a business transaction with an online shopping mall (having a server),

which is connected over the Internet to the online service provider 2 so as to detect (search) in

the customer's order any matching UPC code associated with a discount coupon, stored in

database 40 of online service provider 2, and if a matching UPC code is found, the value of the

coupon is determined or in real-time (transmitting coupon data to inform a retailer of specific

coupon or rebate data associated with an identified customer) and a price reduction is

automatically applied to the customer's order. In a further embodiment, the coupon data

associated with an identified customer can be electronically transmitted to a local retail store

where the customer can redeem the said coupon (col. 11: 29-43).

It is further to be understood that owners (retailers) of retail stores redeeming coupons

can receive from the system information related, for example, to the amount of money due to the

retailers by coupon issuer 14 and distributor 16 for redeeming coupons presented by identified

customers, subsequent to transmitting by the retailers redemption data, including coupon value,

expiration date, product associated with the coupon, the customer's identification, the retail store

where the coupon was redeemed, etc., to the system.

(See abstract; figs. 1, 5; col. 7: 36-55; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claim 9, adjusting a counter or decrement a counter or update an information

regarding the number of coupons issued or downloaded and the number of coupons actually

redeemed subsequent to receiving by a clearinghouse redemption data from a redeeming retail

store to thereby measure the coupon distribution effectiveness and prevent fraudulent activities is

implicitly disclosed or is expected in the Barnett's system, as understood by those skilled in the

art (See abstract).

Claims 23-44 recite limitations already addressed in claims 1-22 respectively and

therefore, these limitations of claims 23-44 are rejected under a similar rationale as respectively

applied to claims 1-22.

As per claim 45, Barnett discloses a system (advertising medium) for distributing over

the Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific

user using a personal computer 6 of fig. 1 linked to a server or a web server or online service

provider 2 having a database 40 (multi-vendor-rebate-list) containing product coupons and

information on products and services (promotional items or advertisements) available for sales at

participating retail stores or online shopping malls and wherein upon connecting to said system

or online service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can

download coupon data directly to his personal computer memory or Hard disk drive where they

can be printed in the form of paper coupons 18 (hard copies-fig. 5). Subsequently, the user takes

the printed coupons to a participating retail store and wherein upon detecting the presence of a

UPC code related to a promotional item associated with a printed coupon in the customer's

order, the coupon is redeemed accordingly, subsequent to verifying the identity of the user or the

bearer of the coupon, and a price reduction is applied to the customer's order and the user's or

customer's transaction data including the coupon redemption information are forwarded to the

coupon distributor 16 and coupon issuer 14 where they can be used to further prepare targeted

coupon packages for the user or customer. In a further embodiment, the user is conducting a

business transaction with an online shopping mall (having a server or e-tail server), which is

connected over the Internet to the online service provider 2 so as to detect (search) in the

customer's order any matching UPC code associated with a discount coupon, stored in database

40 of online service provider 2, and if a matching UPC code is found, the value of the coupon is

determined or generated in real-time (generating a coupon) and a price reduction is automatically

applied to the customer's order.

It is further to be understood that advertisers or vendors or manufacturers or coupon

issuer 14 and distributor 16 should be able to receive, from the system or advertising medium,

information related, for example, to the number of downloaded coupons, demographic profile of

users downloading specific coupons, number of times a particular coupon was viewed by users,

billing statement concerning the amount of money owed by a vendor, etc., subsequent to

transmitting, by a valid or identified vendor or coupon issuer 14 or distributor 16, a request

(inquiry) requesting such information from the advertising medium or provider 2, wherein part of

this information is used to further prepare customized packages (coupons) in order to target

specific users or customers.

Moreover, it is inherent in the prior art (current reference) that each coupon issuer 14 and

distributor 16 (vendor) is assigned an ID, account number or identifier or code used to identify

the coupon issuer 14 or distributor 16, who provide the coupons. The coupon issuer 14 or

distributor 16 can also use the identifier, in the form of a password, code or ID or account

number, to access the advertising medium or provider 2 (as discussed above), as commonly

practiced in the art.

(See abstract; figs. 1, 5; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claim 46, it is inherent in the prior art (current reference) that each coupon issuer

14 and distributor 16 (vendor) is assigned an ID, account number or identifier or code used to

identify the coupon issuer 14 or distributor 16, who provide the coupons. The coupon issuer 14

or distributor 16 can also use the identifier, in the form of a password, code or ID or account

number, to access the advertising medium or provider 2 (as discussed above), as commonly

practiced in the art.

Claims 61-76 recite limitations already addressed in claims 45-60 respectively and therefore, these limitations of claims 61-76 are rejected under a similar rationale as respectively applied to claims 45-60.

Conclusion

The following references, although not used, are considered to be relevant-

WO 97/23838 to Scroggie discloses an incentive distribution network or system for providing purchase incentive offers, such as electronic coupons, recipes, rebates, shopping aids, product samples, supermarket specials, etc. to qualified customers over the Internet. First of all, the customer logs into the system and fills out a registration form where he provides his demographic information including geographical location having a specific zip code and other postal code since the features of the present system are location-dependent. If it is determined by the system that the submitted zip code is a valid zip code, that is a zip associated with a retail store where an electronic coupon can be redeemed, then the system allows the customer to proceed to the main menu and browse among available purchase incentive offers. The system merges customer supplied-information 270 with other purchase incentive data 272 of fig. 12 and creates a printable graphical image of the purchase incentive 282 for transmission or delivery to the identified customer. In one alternate embodiment of the invention, the purchase incentive or electronic coupon is not directly transmitted to the customer instead the terms of the purchase incentive or coupon, for example, are transmitted electronically to a retail store 310 of fig. 13, located in the customer's geographical location or zip code, pre-selected by the said customer,

who receives either a token 316 or an advisory message to present at the retail store 310 during a redemption process. In a further embodiment of the invention, incentives may be targeted to a specific customer based on the customer's purchase history (previous purchase) 502 and transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506, storing customer's registration information, coupled to system's administrator's online web site 508 of fig. 15 having a web server or using a personal web page in the computer network established for each consenting consumer (See abstract; page 10: 4 to page 11: 14; figs. 1-5, 11-16).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240
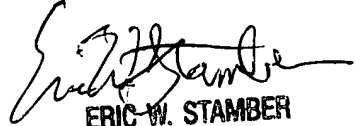
Customer Service- 703-872-9325

Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is

introduced in an amended or new claim may be considered as new matter, especially if the

Application is a Jumbo Application.

JDJ

02/13/03

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